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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,166	02/22/2002	Shon D. Steger	5490-000127/CPC	8434
27572	7590	05/31/2005	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			REIP, DAVID OWEN	
			ART UNIT	PAPER NUMBER
			3731	
DATE MAILED: 05/31/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

**Office Action Summary**

Application No.

10/081,166

Applicant(s)

STEGER ET AL.

Examiner

David O. Reip

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2005.  
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33-66 and 72-107 is/are pending in the application.  
 4a) Of the above claim(s) 42, 46-53, 56-65, 83, 86-91, 94-100 and 102-107 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 33-41, 43-45, 54, 55, 66, 72-76, 80-82, 84, 85, 92, 93 and 101 is/are rejected.  
 7) ☒ Claim(s) 77-79 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 3/29/02, 5/24/02, 3/16/05  
 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group I, species 16 (plate 28N, as seen in Figs. 19-19c) in the reply filed on 2/1/05 is acknowledged.

Claims 48-51, 56, 58-65, 83, 88-91, 94, 97-100, and 102-107 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2/1/05.

Noting the elected species of plate 28N, Figs. 19-19c, the following claims are additionally withdrawn from consideration as being drawn to nonelected species: claims 42, 46, 47, 52, 53, 57, 86, 87, and 95.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33-41, 43-45, 54, 55, and 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 33 recites the limitation "the bridge regions" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 44 recites the limitation "one or more of the bridge regions" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 45 recites the limitation "one or more of the bridge regions" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33-35, 40, 41, 43-45, 54, 55, 66, 72-76, 81, 82, 84, 85, 92, 93, and 101 rejected under 35 U.S.C. 102(b) as being anticipated by Talos et al (U.S. Pat. No. 5,709,686). Fig. 5 of Talos et al (hereinafter "Talos") shows a bone plating device for having all the limitations as recited in the above listed claims, including: a plate having at least two bone fixations (any two adjacent enlarged regions); a tapered bridge region (the reduced width region between any two adjacent enlarged regions), the bridge region defining a "gap" (see Figs. 3, 6, and 9 showing that the bridge region further

Art Unit: 3731

comprises a narrowed portion, which appears semi-circular in cross-section, in the bottom surface of the plate, said narrowed portion defining the "gap"), the bridge region being inherently capable of engagement by a severing device; threaded apertures 5; and a fastening device 6 with a pointed end, a threaded lower shaft portion, and a threaded upper shaft portion 9. Note that although Talos is silent as to the material of manufacture of the plate and screws, both are clearly made from biocompatible material since both are being applied inside the body of a patient.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

Art Unit: 3731

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 39 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talos in view of Tschakaloff (U.S. Pat. No. 5,607,427). As previously discussed, Talos shows a device that is basically the same as that recited in claims 39 and 80. However, Talos fails to disclose bio-resorbable material. Tschakaloff teaches a similar bone plating system comprising bio-resorbable plates and screws. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, in view of Tschakaloff, to modify the Talos plating system to be made from bio-resorbable material, since such a material would allow the plate and screws to absorb into the body following bone healing, reducing or eliminating post-healing complications that can result from metal plates and screws being left in the body of a patient.

***Allowable Subject Matter***

Claims 36-38 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 3731

Claims 77-79 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: claims 36-38 and 77-79 contain allowable subject matter because the prior art fails to disclose or suggest the combination of the plate and fastening device as recited in claims 36 and 77, including wherein the fastening device comprises a head member that is internally threaded for engaging the upper shaft portion.

### ***Conclusion***

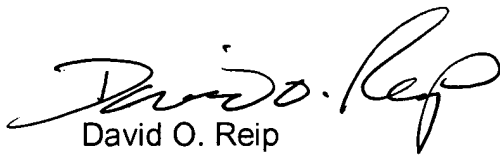
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Selman (U.S. Pat. No. 5,336,224) and Manderson (U.S. Pat. No. 6,488,685) both show bone plating systems comprising at least two bone fixation regions linked by a bridge region, each bridge region being inherently capable of engagement with a severing device such as a wire saw or a jaw-type cutter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David O. Reip whose telephone number is 571-272-4702. The examiner can normally be reached on 7 A.M.- 4 P.M. Mon-Thu and every other Fri..

Art Unit: 3731

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "David O. Reip", is written above the printed name.

David O. Reip  
Primary Examiner  
AU 3731